

ESTTA Tracking number: **ESTTA551763**

Filing date: **08/01/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Hickies, Inc.
Granted to Date of previous extension	08/28/2013
Address	3411 Silverside RoadRodney Building #104 Wilmington, DE 19810 UNITED STATES

Attorney information	Robert B. Golden Lackebach Siegel LLP 1 Chase RoadLackebach Siegel Building Scarsdale, NY 10583-4156 UNITED STATES rgolden@LSLLP.com, nsaraco@LSLLP.com, tmefs@LSLLP.com Phone:914-723-4300
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### Applicant Information

Application No	85790385	Publication date	04/30/2013
Opposition Filing Date	08/01/2013	Opposition Period Ends	08/28/2013
Applicant	Scarfware LLC 9437 Bristol Ridge Court Wellington, FL 33411 UNITED STATES		

### Goods/Services Affected by Opposition

Class 014. All goods and services in the class are opposed, namely: Ankle bracelets; Bracelets; Chokers; Necklaces
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### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	4200125	Application Date	06/07/2010
Registration Date	08/28/2012	Foreign Priority Date	NONE
Word Mark	HICKIES		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 026. First use: First Use: 2010/06/00 First Use In Commerce: 2012/04/30 Shoe laces

Attachments	Notice of Opposition.pdf(627075 bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Robert B. Golden/
Name	Robert B. Golden
Date	08/01/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**Application Serial Nos.:** 85790385  
**Mark:** Hickies  
**International Class:** 14  
**Applicant:** Scarfware LLC  
**Date of Publication:** April 30, 2013

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HICKIES, INC.,	:
	:
Opposer,	:
	:
v.	:
	:
SCARFWARE LLC,	:
	:
Applicant.	:
-----	X

**NOTICE OF OPPOSITION**

Hickies, Inc. ("Opposer"), a corporation duly organized and existing under the laws of the State of Delaware, with offices in Wilmington, Delaware, believes that it will be damaged by the registration of the trademark **Hickies** by Scarfware LLC ("Applicant") as applied for in Application Serial Number 85790385 ("Applicant's Application"), for use in connection with "Ankle bracelets; Bracelets; Chokers; Necklaces" in International Class 14 ("Applicant's Goods").

As grounds for opposition it is alleged that:

1. Opposer is a corporation duly organized and existing under the laws of the State of Delaware with offices in Wilmington, Delaware.
2. Opposer manufactures, promotes, distributes, and sells accessories for shoes and has a bona fide intent to sell footwear, more fully described in the following paragraphs ("Opposer's Goods").

3. Opposer is the owner the mark HICKIES (“Opposer’s Trademark”) for use on or in connection with Opposer’s Goods.
4. Opposer is the owner of U.S. Trademark Registration No. 4200125 for Opposer’s Trademark, registered on August 28, 2012, for use in connection with “shoes laces” in International Class 26 (“Opposer’s Registration”). True and correct copies of Opposer’s Certificates of Registration for Opposer’s Trademark, as well as the TARR and Assignment Records associated with the same, as printed from the U.S. Patent and Trademark Office’s website, are attached hereto as Exhibit 1.
5. Opposer is the owner of U.S. Application Serial No. 85056380 for Opposer’s Trademark, filed on June 7, 2010 for “footwear, namely, rubbers” in International Class 25. A Notice of Allowance was granted on July 5, 2011 in association with this application.
6. Opposer has used Opposer’s Trademark in interstate commerce since approximately June 2010.
7. Through the years, Opposer has expended substantial amounts of money, time and effort in advertising, promoting and popularizing Opposer’s Trademark; the trade, industry, and public have throughout the years associated and attributed usage of Opposer’s Trademark to Opposer and Opposer alone, so that the trade in general and the purchasing public in particular have come to know and recognize Opposer’s Trademark and Opposer’s Goods and to know that the same originate with and belong to Opposer.

8. Opposer has used Opposer's Trademark in interstate commerce openly, notoriously and continuously since the date of first use of Opposer's Trademark.
9. Opposer's Trademark is a strong trademark and has developed goodwill and a good reputation exclusive to Opposer.
10. Upon information and belief, Applicant is a limited liability company, organized and existing under the laws of the State of Florida, with offices at 9437 Bristol Ridge Court, Wellington, Florida 33411.
11. The purported Hickies mark applied for in Applicant's Application is identical and/or confusingly and deceptively similar to Opposer's Trademark, which Opposer has been using long prior to the filing of Applicant's intent to use application; hence, Applicant is not entitled to adopt, use, or seek registration of the purported Hickies mark in connection with the goods identified in Applicant's Application.
12. The goods identified in Applicant's Application are closely related to Opposer's Goods sold under Opposer's Trademark.
13. The goods covered by Applicant's Application are of the type distributed and sold by Opposer and/or within the Opposer's natural zone of expansion, through the same channels of trade and to the same class of customers as Opposer's Goods. Such goods would reasonably be expected by the trade and purchasing public to emanate from or be sponsored by the same source.

14. Opposer's Trademark and Applicant's purported mark are confusingly identical in appearance, connotation and pronunciation, so that contemporaneous use of the respective marks will create a likelihood of confusion, mistake or deception among the trade and consumers.
15. Because of the strength of Opposer's Trademark and because Applicant's purported mark is nearly identical thereto, any faults or imperfections in the goods of Applicant will reflect adversely on Opposer and its established goodwill and reputation, all to the detriment of Opposer unless this opposition is sustained.
16. The simultaneous use and/or registration by Applicant of the mark Hickies will dilute and tarnish Opposer's rights and will eventually result in a lack of designation or indication of origin and a loss of distinctiveness and exclusivity in Opposer's Trademark if Applicant is allowed to register its purported mark.
17. Opposer clearly has superior and paramount rights as compared to Applicant and Opposer has used Opposer's Trademark in commerce continuously since 2010, a date prior to any date claimed by or available to Applicant. Consequently, Opposer avers that confusion, mistake, deception, dilution and tarnishment in the trade and in the minds of the purchasers as between Opposer's and Applicant's marks and as to the origin of their respective goods will be likely and bound to occur with resulting damage to Opposer.

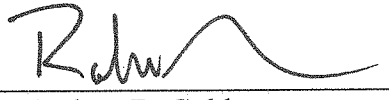
18. For the foregoing reasons, Applicant's Application should be denied registration under Section 2(d) of the Lanham Act (15 U.S.C. §§ 1052(d)).

**WHEREFORE**, Opposer respectfully requests that the Opposition be sustained and that registration of Application Serial No. 85790385 to Applicant for the mark Hickies be refused.

Dated: Scarsdale, New York  
August 1, 2013

Respectfully submitted,

**LACKENBACH SIEGEL, LLP**

By:   
Robert B. Golden  
Attorneys for Opposer  
Lackebach Siegel Building  
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(914) 723-4300  
(914) 723-4301 fax

**CERTIFICATE OF SERVICE**

I hereby certify that a true and accurate copy of the enclosed **NOTICE OF OPPOSITION** was served on Applicant on August 1, 2013, via U.S. 1<sup>st</sup> Class Mail, addressed to counsel for Applicant as follows:

Nancy J. Flint, Esq.  
Nancy J. Flint, Attorney At Law, P.A.  
1844 N. Nob Hill Road # 424  
Plantation, Florida 33322-6548

Dated: Scarsdale, New York  
August 1, 2013

  
Nicole Saraco



# **EXHIBIT 1**

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Mark: HICKIES

HICKIES

US Serial Number: 85976869  
US Registration Number: 4200125  
Register: Principal  
Mark Type: Trademark  
Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.  
Status Date: Aug. 28, 2012  
Publication Date: May 10, 2011  
Application Filing Date: Jun. 07, 2010  
Registration Date: Aug. 28, 2012  
Notice of Allowance Date: Jul. 05, 2011

## Mark Information

Mark Literal Elements: HICKIES  
Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.  
Mark Drawing Type: 4 - STANDARD CHARACTER MARK

## Related Properties Information

International Registration Number: 1106424  
International Application(s) /Registration(s) Based on this Property: A0027824/1106424  
Claimed Ownership of US Registrations: 85056380  
Child Of: 85056380

## Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- \* Brackets [...] indicate deleted goods/services;
- \* Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of
- \* Asterisks \* identify additional (new) wording in the goods/services

For: Shoe laces  
International Class(es): 026 - Primary Class  
Class Status: ACTIVE  
Basis: 1(a)  
First Use: Jun. 2010  
U.S Class(es): 037, 039, 040, 042, 050  
Use in Commerce: Apr. 30, 2012

## Basis Information (Case Level)

Filed Use: No	Currently Use: Yes	Amended Use: No
Filed ITU: Yes	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

## Current Owner(s) Information

Owner Name: HICKIES, INC.  
Owner Address: 3411 SILVERSIDE ROAD  
RODNEY BUILDING #104  
WILMINGTON, DELAWARE 19810  
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where  
Organized: DELAWARE

## Attorney/Correspondence Information

### Attorney of Record

Attorney Name: Howard N. Aronson  
Attorney Primary Email: [tmefs@LSLLP.com](mailto:tmefs@LSLLP.com)  
Address:

Docket Number: 16738  
Attorney Email Yes  
Authorized:

### Correspondent

Correspondent Name/Address: Howard N. Aronson  
Lackebach Siegel LLP  
1 Chase Road  
Lackebach Siegel Building  
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UNITED STATES

Phone: 914-723-4300

Fax: 914-723-4301

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Correspondent e-mail Yes  
Authorized:

### Domestic Representative

Domestic Representative Name: Howard N. Aronson

Phone: 914-723-4300

Fax: 914-723-4301

Domestic Representative e-mail: [tmefs@LSLLP.com](mailto:tmefs@LSLLP.com)

Domestic Representative Yes  
e-mail Authorized:

## Prosecution History

Date	Description	Proceeding Number
Apr. 17, 2013	ATTORNEY REVOKED AND/OR APPOINTED	
Apr. 17, 2013	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Aug. 28, 2012	REGISTERED-PRINCIPAL REGISTER	
Jul. 21, 2012	NOTICE OF ACCEPTANCE OF STATEMENT OF USE MAILED	
Jul. 20, 2012	LAW OFFICE REGISTRATION REVIEW COMPLETED	77976
Jul. 11, 2012	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Jun. 12, 2012	STATEMENT OF USE PROCESSING COMPLETE	70565
May 25, 2012	USE AMENDMENT FILED	70565
Jun. 12, 2012	DIVISIONAL PROCESSING COMPLETE	
May 25, 2012	DIVISIONAL REQUEST RECEIVED	
Jun. 12, 2012	CASE ASSIGNED TO INTENT TO USE PARALEGAL	70565
May 25, 2012	TEAS REQUEST TO DIVIDE RECEIVED	
May 25, 2012	TEAS STATEMENT OF USE RECEIVED	
Jan. 05, 2012	NOTICE OF APPROVAL OF EXTENSION REQUEST MAILED	
Jan. 03, 2012	EXTENSION 1 GRANTED	98765
Jan. 03, 2012	EXTENSION 1 FILED	98765
Jan. 03, 2012	TEAS EXTENSION RECEIVED	
Dec. 23, 2011	ATTORNEY REVOKED AND/OR APPOINTED	
Dec. 23, 2011	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Sep. 14, 2011	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Jul. 05, 2011	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
May 10, 2011	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
May 10, 2011	PUBLISHED FOR OPPOSITION	
Apr. 05, 2011	LAW OFFICE PUBLICATION REVIEW COMPLETED	77976
Apr. 02, 2011	ASSIGNED TO LIE	77976
Mar. 18, 2011	APPROVED FOR PUB - PRINCIPAL REGISTER	
Mar. 18, 2011	TEAS/EMAIL CORRESPONDENCE ENTERED	88889

Mar. 18, 2011	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Mar. 18, 2011	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Sep. 23, 2010	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Sep. 23, 2010	NON-FINAL ACTION E-MAILED	6325
Sep. 23, 2010	NON-FINAL ACTION WRITTEN	76071
Sep. 16, 2010	ASSIGNED TO EXAMINER	76071
Jun. 11, 2010	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jun. 10, 2010	NEW APPLICATION ENTERED IN TRAM	

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### TM Staff and Location Information

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TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Jul. 20, 2012

**United States of America**  
United States Patent and Trademark Office

**HICKIES**

**Reg. No. 4,200,125**

**Registered Aug. 28, 2012**

**Int. Cl.: 26**

**TRADEMARK**

**PRINCIPAL REGISTER**

HICKIES, INC. (DELAWARE CORPORATION)  
3411 SILVERSIDE ROAD  
RODNEY BUILDING #104  
WILMINGTON, DE 19810

FOR: SHOE LACES, IN CLASS 26 (U.S. CLS. 37, 39, 40, 42 AND 50).

FIRST USE 6-0-2010; IN COMMERCE 4-30-2012.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SN 85-976,869, FILED 6-7-2010.

JOHN KELLY, EXAMINING ATTORNEY



*David J. Kybas*

Director of the United States Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL  
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE  
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

**Requirements in the First Ten Years\***  
**What and When to File:**

***First Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. See 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

***Second Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between the 9th and 10th years after the registration date.\*  
See 15 U.S.C. §1059.

**Requirements in Successive Ten-Year Periods\***  
**What and When to File:**

You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.\*

**Grace Period Filings\***

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or  
reminder of these filing requirements.**

**\*ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. See 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. See 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

**NOTE:** Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.